

REMARKS

This amendment responds to the final office action mailed November 9, 2009. In the final office action the Examiner:

- rejected claims 91, 98, and 107 under 35 U.S.C. 112, second paragraph;
- rejected claims 82, 84-88, 91-95, 98-100, 102-104 and 107-111 under 35 U.S.C. 103(a) as being unpatentable over Moody et al. (US 2005/0144157) in view of Doherty (US 2003/0055711);
- rejected claims 83, 89, 96, 101, 105, 110 and 112-117 under 35 U.S.C. 103(a) as being unpatentable over Moody et al. in view of Doherty, and further in view of Rohall et al. (US 2003/0163537); and
- rejected claims 90, 97 and 106 under 35 U.S.C. 103(a) as being unpatentable over Moody et al., in view of Doherty, and further in view of Comer et al. (“Conversation-Based Mail,” hereinafter “Comer”).

The pending claims are claims 82-117.

Related Applications

Office Actions and any Notices of Allowance in US Patent Applications 10/816,427, 10/914,034, 10/914,035, 10/914,036, and 10/914,040 may contain arguments or information relevant to the prosecution of this application. The Examiner is encouraged to review the Office Actions and any Notices of Allowance in the afore-mentioned applications, all of which are available on PAIR.

Amendments to Claims

No claim amendments have been made in this response.

1.131 Affidavits

Enclosed in Appendix A of this response are 1.131 Affidavits for inventors Paul T. Buchheit and Sanjeev Singh. The 1.131 Affidavits each state that the present invention was conceived on or before September 19, 2002 and reduced to practice as early as June 22, 2003.

Rejection under 35 U.S.C. 103(a)

The Examiner has rejected claims 82, 84-88, 91-95, 98-100, 102-104 and 107-111 as being unpatentable over Moody in view of Doherty; rejected claims 83, 89, 96, 101, 105, 110 and 112-117 as being unpatentable over Moody in view of Doherty, and further in view of Rohall; and rejected claims 90, 97 and 106 as being unpatentable over Moody, in view of Doherty, and further in view of Comer.

In summary, all of the rejected claims rely on Moody.

Moody et al. is Not Prior Art

Moody et al. was filed on Dec. 29, 2003 and published on June 30, 2005. As shown in the 1.131 Affidavits in Appendix A, invention was conceived on or before September 19, 2002 and reduced to practice as early as June 22, 2003. Since both Moody was filed and published after the conception and reduction to practice dates of this invention, Moody is not prior art under 35 U.S.C. § 103(a).

The 35 U.S.C. § 103(a) Rejections are Traversed

Since Moody is not prior art, and all the 35 U.S.C. § 103(a) rejections are based on Moody, the rejections are traversed. Withdrawal of the rejections under 35 U.S.C. § 103(a) is requested.

Rejection under 35 U.S.C. 112

The Examiner rejected claims 91, 98, and 107 under 35 U.S.C. 112, second paragraph. Specifically, the Examiner states that the word “substantially” renders the claim(s) indefinite. The Applicant submits that these claims should be read in light of the specification. The specification explains that when comparing subject lines in determining messages in the same conversation, the subject may not be exact matches. (Application as Filed, ¶ [00089] and [000099].) They may for example include different prefixes such as “Re:” and “Fwd.” (Application as Filed, ¶ [00099].) Therefore, the Application explains that these substantially similar conversations should be normalized. (Application as Filed, ¶ [00099].) Thus, after normalization the subject lines will match. The Applicant therefore submits that in the context of the Application, subject lines that are “substantially the same” are subject lines that would be identical after normalization.

By responding in the foregoing remarks only to particular positions asserted by the Examiner, the Applicants do not necessarily acquiesce in other positions that have not been explicitly addressed. In addition, the Applicants' arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

In light of the above amendments and remarks, the Applicant respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 843-4000, if a telephone call could help resolve any remaining items.

Respectfully submitted,

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/ Gary S. Williams /

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Gary S. Williams

(Reg. No.)

MORGAN, LEWIS & BOCKIUS LLP

2 Palo Alto Square

3000 El Camino Real, Suite 700

Palo Alto, CA 94306

(650) 843-4000

APPENDIX A